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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

APPLE, KIRSTEN SACHWITZ

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,838

Applicant(s)

SLOAN ET AL.

Examiner

Kirsten S. Apple

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/18/2005 11/26/04, 2/18/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claim Rejections - 35 USC § 103

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 1-25 under 35 USC 103.

The Applicant attention is re-drawn to the following:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being obvious over Wolfberg et al. (US Patent No. 5,214,579), in view of Sullivan et al. (US Patent No. 6,615, 240), and Ferry et al. (US Patent No. 6,069,628).

Claims 1, 9, 10, and 18:

Wolfberg discloses a method, a system, and a computer program embodied on a computer readable medium for providing a graphical user interface to a financial modeling system allowing advice through projections (Col. 3, line 63-col. 4, line 10, col. 10, lines 40-55, col. 11, lines 27-29, col. 12, lines 38-49, col. 16, lines 4-41, col. 19, lines 24-35, col. 29, lines 18-38, col. 30, lines 3-44) and trends (Col. 23, lines 37-54) of a financial system (Col. 4, line 9-col. 5, line 11) based on a network architecture (Col. 7, line 53-col. 8, line 9), which determine the expectations (Col. 17, line 65-col. 18, line 20) and impact (Col. 1, line 55-col. 2, line 12, col. 2, line 42) of investment decisions. Wolfberg does not exclude that his invention could be used to give advice,

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as a help-system for the investors, but he does not explicitly disclose this possibility of use.

Sullivan discloses an Internet-based system (Col. 1, line 18-col. 2, line 4, col. 4, lines 57-62, col. 5, lines 5-38, col. 13, lines 36-51, col. 14, lines 22-23) that support both live advice (or live help, Abstract, col. 3, lines 36-62; col. 4, line 63-col. 5, line 4, col. 6, lines 20-63, col. 7, lines 12-28, col. 8, lines 9-22, col. 10, line 22-col. 12, line 12, col. 13, line 56-col. 14, line 63, col. 15, line 1-col. 16, line 67, col. 17, line 8-col. 18, line 10) and automated coaching (Abstract, col. 6, lines 39-50, col. 12, lines 39-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the Wolfberg invention was made to use it for a live advice and automated coaching. One would have been motivated to use for live advice and automated coaching the Wolfberg invention in order to maximize its applications, and consequently, the revenues that result from its use.

The Wolfberg-Sullivan invention does not explicitly disclose providing a first window for displaying an image of said live advisor; and providing a second window for displaying context sensitive automated coaching. Ferry discloses a system which provides financial system services (Col. 4, lines 23-64) using a first window (Col. 2, lines 23-55, col. 14, lines 50-67, col. 16, lines 21-39) and a second window (Col. 2, lines 28-49, col. 14, lines 50-67, col. 16, lines 21-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the Wolfberg-Sullivan invention was made to use this step. One would have been motivated to use this

step in the Wolfberg-Sullivan invention in order to facilitate the search of advice for the user.

The Wolfberg-Sullivan-Ferry invention does not explicitly disclose providing a plurality of icons for selecting at least one of a plurality of methods for communicating with a live advisor over the Internet. The examiner takes Official notice that this feature is old and well-known in the computer art because it is very easy for a user to pick an icon instead of giving a command to a financial program by different way.

Claims 2, 11, and 19: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 1, 9, and 18. Wolfberg discloses a network architecture (see Claim 1 above) which could be also the Internet network. Sullivan explicitly discloses Internet (see Claim 1 above), and it is well known that the Internet network is a plurality of methods for communication that includes email, electronic chat, live streaming audio, voice over the network, telephone, still picture, and streaming live video. Therefore, it would have been obvious to one having ordinary skill in the art at the time the Wolfberg invention to use this step. One would have been motivated to use this step in the in order to increase the possibilities of communication for the user.

Claims 3, 12 and 20: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 1, 9, and 18. Wolfberg also discloses an user interface that includes providing one interactive window for displaying a financial model generated by the financial modeling system (Fig 9C).

Claims 4, 13, and 21: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 3, 12, and 20. Wolfberg, Sullivan, and Ferry do not explicitly disclose that the user interface includes a plurality of function icons for performing various operations on said generated financial model. The examiner takes Official notice that this feature is old and well-known in the computer art because it is very easy for a user to pick an icon instead of giving a command to a financial program by different way.

Claims 5, 14, and 22: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 4, 13, and 21. Wolfberg, Sullivan, and Ferry do not explicitly disclose that the function icons include providing at least one of transact, monitor, model, explore, track. The examiner takes Official notice that this feature is old and well-known in the computer art because it is very easy for a user to pick an icon instead of giving a command to a financial program by different way.

Claims 6, 15, and 23: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 3, 12, and 20. Wolfberg also discloses that the user interface includes at least one dynamic window for displaying characteristics related to the generated financial model (Fig. 9C, 10A, 10B, and 10 C).

Claims 7, 16, and 24: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 1, 9, and 18. Sullivan discloses a Financial system service Internet-based the wherein said user interface that includes providing at least one interactive window for displaying help messages related to using the financial modeling system, as is used in many automated coaching systems (see discussion on Claim 1 above).

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Claims 8, 17, and 25: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 1, 9, and 18. Wolfberg, Sullivan, and Ferry does not explicitly disclose wherein said user interface further includes providing at least one profile icon for performing various operations on a user profile based on user information. The examiner takes Official notice that this feature is old and well known in the computer art because it is very easy for a user to pick an icon instead of giving a command to a financial program by different way.

Response to Amendment

Applicant's arguments filed Oct. 18, 2004 have been fully considered but they are not persuasive.

In particular, the Applicant argued:

"(a) The References Fail to Teach or Suggest Displaying an Image of a Live Advisor As Claimed

The present claimed invention recites, *inter alia*, "providing a first window for displaying an image of said live advisor." Wolfberg, Sullivan, and Ferry fail to teach or suggest this limitation. Further, nowhere in the rejection of independent claims 1, 9, and 18 does Examiner indicate where the cited references allegedly teach or suggest displaying an image of a live advisor.

In stark contrast to the claimed invention is the only reference that even discloses dispensing advice, live or otherwise, namely Sullivan. However, Sullivan only describes live "advice" in a limited context: "If necessary, the user also may be placed in contact (e.g., via a voice connection over the telephone, through an on-line Web connection, or the like) with a given technical support engineer." Col. 6, lines 9-12. It is quite clear from a reading of Sullivan that the reference only envisioned a live voice or audio connection. This disclosure is quite distinct from the claimed image of a live advisor insofar as the two require different technologies, formats, and bandwidths are implemented in dissimilar contexts."

The Examiner refutes the argument made by the Applicant and draws the attention back to Sullivan Col. 6, lines 9-12 "via a voice connection over the telephone, through an on-line Web connection, or the like." The examiner concurs the first reference "via a voice connection over the telephone" implies voice or audio connection, however, "through an on-line Web connection, or the like" the examiner argues includes voice and audio (for examples of audio see section B below). It would be known to one of ordinary skill in the art at the time of the invention that audio would be one of the forms of communication used "through an on-line Web connection, or the like.

In addition, although Sullivan does not include an image of a camera or the live advisor in the drawings it would be known to one of ordinary skill in the art at the time of the invention that compatible software and necessary hardware must be included in order to successfully communicate. To highlight the point, it is accepted by the applicant that voice interaction with an operator is possible although no hardware (either a traditional telephone or microphone and speakers for Voice over the network) have been mentioned in the patent."

Applicant additionally argues,

"(b) The References Fail to Teach or Suggest The Plurality of Methods of Communication As Claimed

Claims 2, 11, and 19 further recite "the plurality of methods for communication include... email, electronic chat; live streaming audio, voice over the network, telephone, still picture, streaming live video and a collaborative interactive page: Wolfberg, Sullivan, and Farry fail to teach or suggest these limitations.

Examiner first notes that the Sullivan reference discloses the Internet, and then Examiner asserts:

...[I]t is well known that the Internet network is a plurality of methods for communication that includes email, electronic chat, live streaming, audio, voice over the network, telephone, still picture, and streaming live video. Therefore, it would have been obvious to one having ordinary skill in the art at the time the Wolfberg invention to use this step. One would have been motivated to use this step in order to increase the possibilities of communication for the user.

The Examiner refutes the argument made by the Applicant and draws the attention back to Sullivan Col. 6, lines 9-12 "via a voice connection over the telephone, through an on-line Web connection, or the like." The examiner argues "Voice connection over the telephone" includes "telephone" while "through an on-line Web connection or the like" includes at least "email, electronic chat, live streaming, audio, voice over the network, still picture and streaming live video." It would be obvious to one of ordinary skill in the art at the time of the invention that all of these modes of communication could be done and are implied with "live help"... "through an on-line Web connection or the like."

The Applicant requests documentary evidence that these methods of communication "are known to one of ordinary skill in art at the time of the invention"

"Applicants respectfully disagree with this reasoning and traverse the same because (1) Examiner has not provided adequate evidentiary support to establish that implementing the claimed methods for communication in a financial modeling system would be obvious to one skilled in the art, and (2) even assuming *arguendo* that such support existed, there is no evidence that such support existed "a the time the invention was made.

As noted above, Examiner asserts that the claimed methods for communication would have been obvious. However, Examiner has not provided evidentiary support thereof and Applicants respectfully traverse in accordance with MPEP § 2144.03 (C). Specifically, merely implementing the claimed methods of communication on the Internet in general is distinct from implementing them for use in a financial modeling system, and the latter would not have been obvious because providing such multimedia communications was not in demand or practiced for financial modeling

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system interfaces. Accordingly, Applicants respectfully request documentary evidence in support of Examiner's position.

Further, even assuming *arguendo* that such evidentiary support exists, the rejection has not satisfied 35 U.S.C. § 103(s), which requires that the entire subject matter of the claimed invention. Obvious "at the time the invention was made." Specifically, Applicants assert that it was not obvious at time of filing that communications through the various claimed means for a financial modeling system would "increase the possibilities of communication for the user," as asserted by Examiner. The requirement "at the time the invention was made" is present to avoid impermissible hindsight. See MPEP § 2141.01. Not only was there insufficient bandwidth across the Internet to make the claimed forms of communication obvious, but the discrepancies among communications formats any standards were insufficiently established to make them obvious."

The Examiner respectfully draws the attention of the Applicant to "Sams Teach Yourself the Internet in 24 Hours", by Ned Snell, (herein referred to as "Snell".) Please note Snell was published June 17, 1999 before the filing date of November 01, 2001 and before the Continuation In Part of 09/431,684 dated November 01, 1999.

This teaching of Snell is considered to be help guides to novices of what is know in the industry or "known to those of ordinary skill in the art" such as the name suggests "Sams Teach Yourself the Internet in 24 hours."

Snell teaches all of the "methods of communication," including: ... *email* (see Snell, hour 12), *electronic chat* (see Snell, hour 18); *live streaming audio* (see Snell, hour 17, "voice conferencing"), *voice over the network* (see Snell, hour 17 "internet phone calls"), *and streaming live video* (see Snell, hour 17, "video conferencing").

Since the examiner now has supplied references supporting the official notice assertions, the claims 1, 9, 18; 2, 11, 19; and all of the dependent claims are subsequently reject as well.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Details

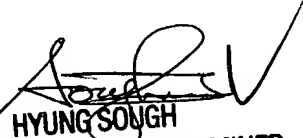
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571.272.6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa


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